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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,579	07/12/2001	Carl S. Chow	10007750-1	4263
22879	7590	12/12/2008	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			ROBINSON BOYCE, AKIBA K	
ART UNIT	PAPER NUMBER			
			3628	
NOTIFICATION DATE		DELIVERY MODE		
12/12/2008		ELECTRONIC		

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CARL S. CHOW

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Appeal 2008-4035  
Application 09/905,579  
Technology Center 3600

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Decided: December 10, 2008

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*Before* MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

MOHANTY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 19-34. Claims 1-18 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF THE DECISION

We AFFIRM.

## THE INVENTION

The Appellant's claimed invention is directed to a method and apparatus for distributing literature to clients on a customized basis. The apparatus includes a database containing literature. The literature selected by the client is assembled and printed onto sheets of media to form a booklet to be mailed or given to the client (Specification, 5:10-15). Claim 19, reproduced below, is representative of the subject matter of appeal.

19. A method, comprising:
  - providing a client interface, a literature assembly algorithm, and a database containing information, wherein the client interface comprises at least a portion of a network;
  - detecting a client inquiry via the client interface;
  - presenting the information to the client via the client interface in response to the inquiry;
  - receiving a client selection of at least a portion of the information via the client interface in response to presenting the information;
  - in response to receiving the client selection, assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document;
  - obtaining an electronic image, comprising:
    - the document; and,
    - a postage marking calculated based on a total weight of a booklet; and,
    - printing the electronic image onto one or more sheets of print media.

## THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Long	EP 0 621 563 A1	Apr. 4, 1994
Tonkin	US 6,134,568	Oct. 17, 2000

The following rejections are before us for review:

1. Claims 19-34 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.<sup>1</sup>
2. Claims 19-34 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tonkin and Long.

## THE ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in rejecting claims 19-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. This issue turns on whether claims 19 and 27 recite “wherein the client does not specify an arrangement of components to create the document.”

The second issue is whether the Appellant has shown that the Examiner erred in rejecting claims 19-34 under 35 U.S.C. § 103(a) as unpatentable over Tonkin and Long. This issue turns on whether it would have been obvious to combine the disclosed teachings of Tonkin and Long to meet the claimed invention.

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<sup>1</sup> We note that the Examiner has not withdrawn the rejection of claims 19-34 under 35 U.S.C. § 112, first paragraph, officially as it remains listed at page 3 of the Answer.

## FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence<sup>2</sup>:

FF1. Claims 19 and 27 do not include the limitation for “wherein the client does not specify an arrangement of components to create the document.” (Br. Claim Appendix; also Amendment After Final Rejection filed January 31, 2007 and indicated as to be entered in the Advisory Action mailed February 21, 2007).

FF2. Claim 19 includes the limitation “in response to receiving the client selection, assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document.” (Br. Claim Appendix).

FF3. Claim 27 includes the limitation “in response to receiving the client selection, assembling the selected data into a document, wherein the algorithm automatically specifies an arrangement of components to create the document.” (Br. Claim Appendix; also Amendment After Final Rejection filed January 31, 2007 and indicated as to be entered in the Advisory Action mailed February 21, 2007).

FF4. Tonkin discloses a system to enable a user to preview a document by providing a user interface and inputting, via the interface, information specifying an arrangement components to create a document including a page, tab page, front and back cover, and binding (Col. 2:27-40).

FF5. Tonkin discloses that the system can be used on the Internet (Col. 3:57-65).

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<sup>2</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF6. Tonkin discloses that the system can be used to create a booklet (Fig. 8B).

FF7. Tonkin discloses that a user may “accept” the document in which case the document specification is transmitted via the Internet or another communication system to the processing facility (Col. 13:17-24).

FF8. Tonkin discloses that the formatted information includes a document summary listing the source file name (Col. 13:42-47).

FF9. Tonkin discloses that the systems computer specifies the arrangement of the components to create the document as claimed since the specification is transmitted and formatted.

FF10. Tonkin inherently claims that an algorithm automatically specifies an arrangement of components to create the document after user selection since the information is formatted and transmitted over the Internet.

FF11. Long discloses a system for preparing letters for mailing (Col. 1:5-6).

FF12. Long discloses determining the weight of an envelope stuffed with inserts and using a franking machine to print the proper postage onto printed material. (Col. 5:42-56).

## PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727,

1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

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obviousness’’)). However, ‘‘the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.’’ *Id.*

## ANALYSIS

### *Claims Rejected under 35 U.S.C. § 112, first paragraph*

The Examiner has rejected claims 19-34 under 35 U.S.C. § 112, first paragraph for lack of enablement. The Examiner argues that claims 19 and 27 were amended to include the limitation reciting ‘‘wherein the client does not specify an arrangement of components to create the document’’ (Ans. 3). The Examiner argues that Fig. 4 and the written specification do not provide support for such a limitation (Ans. 3).

The Appellant argues the limitation to reciting ‘‘wherein the client does not specify an arrangement of components to create the document’’ was removed by amendment from the claims and that the Examiner has mistakenly applied the rejection of the claims 19-34 under 35 U.S.C. § 112, first paragraph (Reply Br. 2-3).

We agree with the Appellant. The PTO bears the initial burden when rejecting claims for lack of enablement.

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the

specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling.

*In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993) (citing *In re Marzocchi*, 439 F.2d 220, 223-24 (CCPA 1971)).

We note initially that an examination of the Examiner Answer (Ans. 2) indicates that the status of the amendment after final, the grounds of rejection to be reviewed, as well as the copy of the appealed claims in the Appear Brief and Appendix is correct. An examination of claims 19 and 27 as presented in the Appeal Brief Appendix finds no limitation reciting “wherein the client does not specify an arrangement of components to create the document” as noted by the Appellant (FF1). This limitation was removed by the Amendment After Final Rejection filed January 31, 2007 and indicated as to be entered in the Advisory Action mailed February 21, 2007.

Here the Examiner has failed to set forth a reasonable explanation as to why it is believed that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the Specification of the application because the limitation referred to has been removed from the claims as noted by the Appellant. For this reason the rejection of claims 19-34 under 35 U.S.C. § 112, first paragraph, for lack of enablement is not sustained.

#### *Claim Construction*

The Appellant argues that the rejection of claims 19 and 27 under 35 U.S.C. § 103(a) as unpatentable over Tonkin and Long is improper because

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Tonkin fails to disclose “providing … a literature assembly algorithm, and … assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document” (Br. 4 and 11). The Appellant argues that when viewed in light of the Specification this limitation includes “automatically organizing the requested literature together in a logical sequence and order” (Br. 6 and 13).

In contrast the Examiner has determined that the claims do not require that “organization of the requested literature together in a logical sequence and order” because limitations from the Specification are not to be read into the claims (Ans. 11).

We first construe the meaning of the term “literature assembly algorithm” as used by the Appellant in the claims. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004)

Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a

claim when the claim language is broader than the embodiment.

The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims.

*See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Turning to the portion of the Specification referred to by the Appellant:

The literature assembly algorithm 205 can comprise a series of computer-executable steps (a "program") which can be stored in the memory 201 and executed by the processor 215. That is, the literature assembly algorithm 205 is preferably configured to cause the processor 215 to access the database 203 and to retrieve there from the specific literature which is requested by the client "C." After accessing the database 203, and retrieving the requested literature therefrom, the literature assembly algorithm 205 causes the processor 215 to organize the requested literature together in a logical sequence and order, and formats the literature for printing in the booklet "B" to be produced by the booklet-producing device 130.

(Specification 10, emphasis added.)

Here the Specification only states that the literature assembly "can" comprise or is "preferably configured" to access the database 203. There is no requirement in the Specification that this step takes place or that the next step to "organize the requested literature together in a logical sequence and order" takes place. Accordingly, there is no description in the Specification that would lead one of ordinary skill in the art to view the term "literature

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assembly algorithm” to include the requirement that it would be “automatically organizing the requested literature together in a logical sequence and order.”

*Rejection of claims under 35 U.S.C. § 103(a)*

The Appellant argues that the rejection of claims 19 and 27 under 35 U.S.C. § 103(a) as unpatentable over Tonkin and Long is improper because the Examiner has not shown appropriate motivation to combine the references (Br. 6-9 and 13-15). The Appellant also argues that the Examiner has made the combination of references with impermissible hindsight (Br. 9-10 and 15-16). The Appellant also argues that the prior art references teach away from the claimed invention (Br. 10-11 and 17). The Appellant also argues that Tonkin expressly teaches that the user inputs information specifying the arrangement of the document while the claims require that an algorithm automatically specifies arrangement of the document (Reply Br. 4).

The Examiner has determined that Tonkin does disclose the algorithm to automatically specify arrangement of the document (Ans. 5). The Examiner has determined that it would be obvious to calculate the postage for a booklet of Tonkin based on the weight of the booklet and to print the image for the purpose of charging the proper postage for the booklet (Ans. 7).

We agree with the Examiner. Initially we note that claim 19 requires that “in response to receiving the client selection, assembling the selected information into a document, wherein the algorithm automatically specifies an arrangement of components to create the document” (FF2). Claim 27 contains a similar limitation (FF3). The claimed limitation for the algorithm

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automatically specifying an arrangement of the components to create the document is only in response to receiving the client selection. That is, after receiving the user selection, the algorithm automatically specifies an arrangement of the documents. Tonkin meets this claimed limitation and has disclosed that the systems computer specifies the arrangement of the components to create the document (FF9). The Appellant has also argued the word “booklet” does not appear in the Tonkin reference (Br. 9, 16) and is not suggested. We disagree in this regard as Tonkin clearly discloses a booklet being previewed (FF6) even though the term “booklet” is not used.

With regards to the Appellant’s argument that there is no motivation to combine the references note that in *KSR*, the Supreme Court rejected the Federal Circuit’s rigid application of its teaching, suggestion, motivation test in favor of an expansive and flexible approach. *Id.*, 127 S. Ct. at 1739. Here, Tonkin discloses system to enable a user to preview and create a document using a user interface (FF4). Long discloses determining the weight of an envelope stuffed with inserts and using a franking machine to print the proper postage onto printed material (FF12). One of ordinary skill in the art would see the advantage of both previewing and preparing for mailing a document in the same system to save time and for efficiency. Clearly, the system of Tonkin would be used to print material and Long has disclosed printing postage onto printed material (FF12). The modification of the system of Tonkin which is used to create and print a document to also determine the weight of the document and to print the proper postage onto the printed material as disclosed by Long is considered an obvious combination of familiar elements yielding predictable results with rational underpinning.

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For the above reasons the rejection of claims 19 and 27 under 35 U.S.C. § 103(a) as unpatentable over Tonkin and Long is sustained. The Appellant has not argued the limitations of claims 20-26 and 28-34 separately and the rejection of these claims is accordingly sustained for the same reasons.

#### CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 19-34 under 35 U.S.C. § 112, first paragraph.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 19-34 under 35 U.S.C. § 103(a) as unpatentable over Tonkin and Long.

#### DECISON

The Examiner's rejection of claims 19-34 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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